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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/731,231	12/07/2000	Karl Guegler	CL001007	8743
25748	7590	11/04/2003	EXAMINER	
CELERA GENOMICS CORP. ATTN: WAYNE MONTGOMERY, VICE PRES, INTEL PROPERTY 45 WEST GUDE DRIVE C2-4#20 ROCKVILLE, MD 20850			FRONDA, CHRISTIAN L	
			ART UNIT	PAPER NUMBER
			1652	

DATE MAILED: 11/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/731,231

Applicant(s)

GUEGLER ET AL.

Examiner

Christian L Fronda

Art Unit

1652

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 05 September 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: 4, 8, 9, and 24-30.


Claim(s) withdrawn from consideration: \_\_\_\_\_

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☒ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). 9/5/03
10. ☐ Other: \_\_\_\_\_

Continuation of 5. does NOT place the application in condition for allowance because: Applicants' arguments filed 9/5/2003 have been fully considered but they are not persuasive for reasons of record and for the following reasons: Applicants' position that the claimed invention is supported by a specific and substantial asserted utilities since Applicants assert that homology analysis shows in absence of enzymatic assays that the protein of SEQ ID NO: 2 is a serine/threonine kinase and that the claimed invention has "active-site signature" residues at 154-166 of SEQ ID NO:2.

The Examiner disagrees with Applicants' position since the homology analysis does not definitely conclude that the claimed invention is a serine/threonine kinase in absence of enzymatic activity assay. Furthermore, Serine/threonine protein kinases are known in the prior art as a large family of protein kinases with different biological functions and substrate specificity. Applicants have not determined the specific biological function, substrates, and targets of the claimed serine/threonine protein kinase nor have Applicants identified a role for the protein kinase of SEQ ID NO: 2 in any disease or determined if the protein of SEQ ID NO: 2 has protein kinase activity.

Substantial utility is one that provides a specific benefit in currently available form at the time of filing of the invention. However, the main utility of the nucleic acid and protein is to carry out further research to identify the biological function and possible diseases associated with the protein. Utilities that require or constitute carrying out further research to identify or reasonably confirm a specific use are not substantial utility and do not provide a specific benefit. Thus, the claimed invention has no specific or substantial asserted utility..



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